

Application No. 10/813 153

Attorney Docket No. 2022D.PC

**REMARKS**

Claims 17-30 are pending. Claims 17-30 stand rejected. Claim 17 has been amended to correct for antecedent basis. Accordingly, no new matter is introduced with these amendments.

**Specification**

The Examiner has requested clarification from Applicant regarding use of the term 'proposed' in the Examples for the INCI designations of the polyurethane/polyacrylates copolymer. The term 'proposed' in this context simply indicates that the INCI designation for this copolymer (the name of the ingredient used on the label of a product) had been submitted for use as such at the time of the filing of this application. Applicants have since been notified that the INCI name has been granted as "polyurethane-14 (and) acrylates copolymer".

**Reply to the Rejection of Claims 29 and 30 under 35 U.S.C. § 112, 1<sup>st</sup> Paragraph**

Claims 29 and 30 have been rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Specifically, the Examiner states –

Applicant's claims are drawn to skin care compositions comprising solubilized anionic polyurethane and at least one solvent and further comprising therapeutic additive (claim 29) or the additive is selected from the group consisting of additives used to treat dermatitis hypetiformis, warts, urticaria, hives, scars, keloids, scleroderma, lupus erythematosus, hirsutism, acne, pimples, athlete's foot, and herpes (claim 30). There is no description in the specification to the compounds used to treat the various disorders. There is neither description in each category nor exemplification.

Claims draw to skin care compositions, employing this language at the point of novelty, such as applicants', neither provide those elements required to practice the inventions, nor "inform the public" during the life of the patent of the limits of the monopoly asserted. The expression could encompass myriad of compounds and applicants claimed expression represents only an invitation to experiment regarding possible compounds.

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For the following reasons, Applicants respectfully traverse the Examiner's rejection of claims 29 and 30 as failing to comply with the written description requirement.

Firstly, it is noted that the Examiner alleges that the claims fail to comply with the written description requirement, and then argues lack of enablement ("invitation to experiment"). Regarding the written description requirement, a *prima facie* case for such a rejection requires showing why one skilled in the art the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation of "unpredictability in the art" is not a sufficient reason to support a rejection for lack of adequate written description (MPEP § 2163.04).

The Section 112 enablement requirement implicitly tolerates a disclosure requiring experimentation to make or use the claimed invention so long as the experimentation is not undue or unreasonable (*see, e.g., In re Swartz*, 232 F.3d 862, 863, 56 USPQ2d 1703, 1703 (Fed. Cir. 2000, "To satisfy the enablement requirement of § 112, ¶ 1, a patent application must adequately disclose the claimed invention so as to enable a person skilled in the art to practice the invention at the time the application was filed without undue experimentation"; *see also, Christianson v. Colt Industries Operating Corp.*, 822 F.2d 1544, 15623 USPQ2d 1241, 1254 (Fed. Cir. 1987), "The requirement for disclosure of sufficient information to enable one skilled in the art to practice the best mode of the *claimed* invention is and has been proven fully adequate for over 150 years"; *Massachusetts Institute of Technology v. AB Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985) "[T]he fact that experimentation may be complex . . . does not necessarily make it undue, if the art typically engages in such experimentation"; *Atlas Powder Co. v. E.I. DuPont de Nemours & Co.*, 750 F.2d 1569, 224 USPQ 409, 414 (Fed. Cir. 1984) holding that a district court did not err in finding the patent specification enabling even though it listed elements that could form thousands of end products some of which may not be operative, citing *In re Dinh-Nguyen*, 492 F.2d 856, 858-59, 181 USPQ 46, 48 (CCPA 1973) "It is not a function of the claims to specifically exclude . . . possible inoperative substances").

The present description states that therapeutic additives refers to those additives used to treat various skin conditions "as described in *Modern Pharmaceuticals*"

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(Specification: p. 4, lines 13-19). Which additives would be required for the particular type of skin condition would be well known to one skilled in the art. The text cited would further provide guidelines in this regard. Accordingly, the written description enables one skilled in the art to practice the claimed inventions. Further, a person skilled in the art would recognize in Applicants' disclosure a description of the invention as defined by claims 29 and 30.

It is believed that these amendments overcome the Examiner's rejection of claims 29 and 30 as failing to comply with the written description requirement. Withdrawal, therefore, of this rejection is respectfully requested.

**Reply to the Rejection of Claims 29 and 30 under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph**

Claim 21 has been rejected under 35 U.S.C. § 112, second paragraph as lacking clarity. Specifically, the Examiner states applicants are relying on U.S. Patents in the specification for anionic polyurethane and ask if those references disclose 'preneutralized' polyurethane.

Pre-neutralization is mentioned in U.S. Patent No. 5,968,494 at col. 7, lines 24-39. Such step confers solubility or dispersibility in water (col. 7, lines 63-65 of the '494 patent).

It is believed that these remarks overcome the Examiner's rejection of claim 21 for indefiniteness. Withdrawal, therefore, of this rejection is respectfully requested.

**Reply to the Rejection of Claims 16-20 and 22-28 under 35 U.S.C. § 102(e)**

Claims 16-20 and 22-28 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,264,933 to Bodelin *et al.* ("Bodelin"). Specifically, the Examiner states –

The specification does not define the meaning for "treating skin". the specification various examples drawn to cosmetic compositions and based upon the disclosure it is the examiners position that "treating skin" is equivalent to cosmetic compositions applied to skin.

See the abstract for "costing the keratin fibers" which reads on the claimed method and color cosmetics of claim 22. see claim 11 for "anionic polyurethane" claimed in the instant application, see also col. 4, lines 5-15 for the ranges, see col. 4, line 48 for "polyacrylates and polymethacrylates" which is the claimed second solubilized polymer. See

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also the ranges. At lines 29-30. the lower range reads on the claims 2325 and the claimed ranges of both the polymers are within the claimed ranges for claims 26-28.

For the following reasons, Applicants respectfully traverse the Examiner's rejection of claims 16-20 and 22-28 as lacking novelty over Bodelin.

Referring to Bodelin therein is disclosed a cosmetic composition for keratin fibers (mascara for eyelashes) formed from at least one lamellar filler and an aqueous phase dispersed in a liquid fatty phase containing at least one volatile organic solvent. The aqueous phase contains a polymer system comprising at least one film-forming polymer dispersed in the aqueous phase in the form of **solid particles** (Abstract; col. 1, lines 55-63; col. 2, lines 18-21).

In contrast to Bodelin, the present invention is directed towards a method for treating skin involving applying to the skin a skin care composition formed from at least **solubilized** anionic polyurethanes and at least one solvent. As Bodelin does not teach or suggest solubilized polyurethanes, it cannot be said to anticipate the presently claimed invention.

For at least these reasons, Bodelin does not teach or suggest each and every element of claims 16-20 and 22-28 and therefore cannot be said to anticipate the presently claimed invention. Withdrawal, therefore of the rejection of claims 16-20 and 22-28 as being anticipated by Bodelin is respectfully requested.

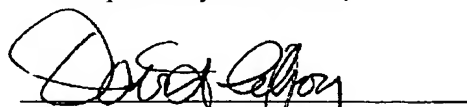
It is believed that the above amendments and remarks overcome the Examiner's rejections of the claims. Withdrawal of those rejections is respectfully requested. Allowance of the claims is believed to be in order, and such allowance is respectfully requested.

Respectfully submitted,

Dated: 24 January 2005

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